

REMARKS

Claims 1-30 are pending in the application. Claims 1-30 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Murakami et al. (US 6,108,674), in view of Lieberman, "Autonomous Interface Agents", March 1997, and in further view of Katz et al. (US 5,404,295).

Applicant respectfully requests reconsideration in view of the foregoing amendments and the remarks hereinbelow.

Rejection of Claim 1, 2, 4-6 under 35 U.S.C. 103(a):

The Question of Obviousness of Combining Murakami et al. and Lieberman:

In Murakami et al., a keyboard is used to enter the contents of a document. The user may enter a specific command to start an image output program, whereupon illustrations matching the contents of the document are inserted into the document. The Examiner notes correctly that Murakami et al. does not teach a system that continuously monitors the document contents to automatically propose images to the user for inclusion into the document, but the Examiner suggests (1) that this is taught by Lieberman and (2) that it would have been obvious to combine the teachings of Murakami et al. and Lieberman. Applicants respectfully traverse this conclusion.

Lieberman discloses two types of agents: (1) *interface agents* that are programs that can affect the objects in a direct manipulation interface without explicit instruction from the user and (2) *autonomous agents* that operate in parallel with the user. Examples given by Lieberman on interface agents include tutoring systems and context-sensitive help systems. Lieberman's examples of autonomous agents include web browsing according to a user's prior interests. Lieberman does not suggest that agents can be used to retrieve stored images. It is the non-obvious recognition of this ability that is an important feature of the present invention.

In *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467, 15 L. Ed. 2d 545, 86 S. Ct. 684 (1966), the Supreme Court requires that the Examiner must explain why the proposed modification would be obvious. Referring to the Office Action, the Examiner's reason for finding obviousness is "*because it would supply the autonomous agent a continual supply of desired output image data based on selected keywords of textual files.*" In other words, it would be

obvious because it would be useful. Being “useful” is one of the requirements for patentability, not a sign of obviousness.

The Courts require the Examiner to identify where the prior art provides a motivating suggestion for the modification, as for example, in the decision in *In re Jones*, 958 F.2d 347, 21 USPQ.2d 1941 (Fed. Cir. 1992), where the Court held:

"Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so ... *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ.2d 1596, 1598-99 (Fed. Cir. 1988). "[at 1943]

"The prior art must provide one of ordinary skill in the art the motivation to make the proposed molecular modifications needed to arrive at the claimed compound. "[at 1944]

Moreover, the Courts have advocated that even if the prior art may be modified as suggested by the Examiner, the modification is not obvious unless the prior art suggests the desirability for the modification, as for example, in the decision in *In re Fritch*, 922 F.2d 1260, 23 USPQ.2d 1780 (Fed. Cir. 1992), where the Court held:

"Mere fact that prior art may be modified to reflect features of claimed invention does not make modification, and hence claimed invention, obvious unless desirability of such modification is suggested by prior art ... "[at 1780]

"The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Gordon*, 733 F.2d at 902, 221 USPQ at 1127. "[at 1783]

It has been held that the motivating suggestion must be explicit, as was decided in the seminal case of *Winner International Royalty Corp. v. Wang*, No. 96-2107, 48 USPQ.2d 1139 (D.C.D.C. 1998), where the Court held:

" ... invention cannot be found obvious unless there was some explicit teaching or suggestion in art to motivate

one of ordinary skill to combine elements so as to create same invention. "[at 1140]

" ... there must have been some explicit teaching or suggestion in the art to motivate one of even ordinary skill to combine such elements so as to create the same invention. "[at 1144]

In the present application, the Examiner's mere agreement with the applicant that the invention provides a useful and desirable result cannot be considered to be evidence of obviousness.

The Question of Relying on Katz to Show Annotations:

Claim 1 calls for the provision of suggested annotations from which the user selects for association with images. Referring to the specification, images could be annotated with text labels identifying the image subject matter, such as in a document, email note, or other human perceivable output. Katz, on the other hand, relates to computer retrieval of database material., and has nothing to do with annotation of images in output documents. Nor does Katz disclose the provision of suggested annotations to the user for the images.

The Examiner's statement of what is disclosed by Katz does not reflect an understanding of what is claimed. The primary reference fails to disclose annotation of images in output documents by providing the user with suggested annotations for the images. Katz fails to disclose, in conceptual terms, the information undisclosed by the primary reference. Assuming arguendo that the references might be capable of combination, there is at least one limitation in the claimed invention that is not disclosed by the references individually or in combination. "Each element of a claim is material." *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 227 USPQ 657,666 (Fed. Cir., 1985)

Rejection of Claims 3 and 8 under 35 U.S.C. 103(a):

Claims 3 and 8 depends from Claim 1 and is patentable therewith. Claim 3 further calls for automatically updating the metadata for matched images with suggested annotations. Claim 8 calls for the provision of the user with the capability of adding annotations to the matched images. Katz, which is cited by the Examiner as teaching annotations, does not suggest updating metadata with annotations. The Examiner points to a portion of Murakami et al. for this

teaching, but, of course this is not possible since Murakami et al. does not relate to annotations.

Rejection of Claim 7 under 35 U.S.C. 103(a):

Claim 7 depends from Claim 1 and is patentable therewith. Claim 7 further calls for determining the context based upon the proximity of typed words to the cursor location. The Examiner correctly states that Murakami et al. teaches insertion of an illustration at the cursor position; but fails to find a disclosure of determining the context based on the position of the cursor. Since not one of the references discloses the determination of the context based on the cursor location, there is at least one limitation in the claimed invention that is not disclosed by the references individually or in combination.

Rejection of Claims 9-12 under 35 U.S.C. 103(a):

Claim 9 calls for ranking the matched images according to context. The Examiner states that Murakami et al. teaches image retrieval based on three keywords, and that this disclosure “suggests” image retrieval ranking. Even if this “suggestion” were in fact true, it would not meet the terms of the claims, which require display of the images according to their rank. Claims 10-12 depend from Claim 9 and are patentable therewith. These dependent claims further define the invention by structure not found in the references of record.

Rejection of Claims 13-30 under 35 U.S.C. 103(a):

The Office Action does not offer independent grounds for rejection of Claims 13-30. Instead, the Office Action suggests that the rationale for their rejection is the same as for Claims 1-13 [sic.]. As such, Applicant can only refer the Examiner to the arguments for patentability set forth above with respect to Claims 1-12, and further point out that Claims 13-30 contain limitations not found in Claims 1-12 and not addressed by the Examiner. For example:

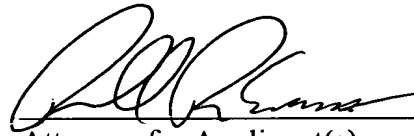
- Claims 13-21 and 24 are limited to e-mail applications and the provision of the capability of moving matched images into the message window of e-mail, not disclosed in the prior art of record.
- Claim 18 provides for ranking based on the number of matched keywords.
- Claim 19 calls for ranking based on the temporal distance between the keyword and the associated metadata.

- Claim 20 recites basing ranking on a confidence level for manually selected keyword annotations.
- Claim 21 requires ranking based on spatial or geographic correspondence between keyword and the metadata.

Conclusion:

It is respectfully submitted, therefore, that in view of the above remarks, that this application is now in condition for allowance, prompt notice of which is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Roland R. Schindler II', written over a horizontal line.

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